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10/761,616

01/20/2004

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06/09/2009

EXAMINER

LEFF, STEVEN N

ART UNIT

PAPER NUMBER

1794

NOTIFICATION DATE

DELIVERY MODE

06/09/2009

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

chicago.patents@klgates.com

| | | | |
|----------------------------------------------------------------------------------------------|----------------------------------------------|------------------------------------------|--|
| <p align="center">Advisory Action Before the Filing of an Appeal Brief</p> | <p>Application No. 10/761,616</p> | <p>Applicant(s) HU ET AL.</p> | |
| | <p>Examiner STEVEN LEFF</p> | <p>Art Unit 1794</p> | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 May 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-8 and 10-20.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.

/Drew E Becker/
Primary Examiner, Art Unit 1794

Continuation of 3. NOTE: Applicants additional claim limitations raise new issues which require further consideration since independent claims 1 and 20 not require the filler being a "water-absorbent material" or that the filler has a water absorbent properties which provide a water absorbency rate of the package of at least 200%. It is further noted that claim 17 which depends from claim 13 which depends from claim 1 did not previously require these additional limitations thus further raising new issues which would require further consideration. It is further noted that independent claim 20 did not previously require these limitations in itself or any dependent claims. In addition it is noted that claim 6 did not previously require that the water insoluble material itself be water-absorbent but that the filler "comprises a water-absorbent material".

Continuation of 11. does NOT place the application in condition for allowance because: With respect to applicants argument that Stipp does not teach specific aspects of applicants invention, applicant is urged to column 3 lines 30-60 which teaches that the package contains a filler comprising a water insoluble material adapted to maintain extraction pressure of the beverage during progressive dissolution of the water-soluble beverage material at a pressure above that which is created by the sole resistance of the first and second surfaces when the package is emptied of the water-soluble material (col. 9 lines 32-37), and that the filler comprises a water-absorbent material which includes fresh ground coffee, spent ground coffee or a combination thereof (col. 3 lines 23-60). Applicant is further urged to col. 9 lines 24-28, col. 9 lines 10-12 which teaches that the water-soluble material comprises coffee that is present in an amount that provides at least 10 to 40 weight percent of the total coffee solids in the final beverage and that the water-soluble material includes soluble coffee powder, milk powder, a creamer substitute powder or mixtures thereof (col. 9 lines 25-26, col. 4 lines 1-60). Therefore although applicant states that Stipp does not teach applicants specific water absorbency rate, as was previously noted, although Stipp does not specifically state a percentage of absorbency rate for the package, Stipp does teach the same referenced materials at applicants desired ratio by volume and thus Stipp is taken to meet the instant claims since it would be expected that the percentage of absorbency rate for the package would thus be the same, absent any clear and convincing evidence and/or arguments to the contrary. However, it is further noted that "the arguments of counsel cannot take the place of evidence in the record", *In re Schulze*, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). It is the examiner's position that the arguments provided by the applicant regarding Stipp not teaching applicants intended water absorbency, in light of Stipp specifically teaching the same referenced materials at applicants desired ratio by volume, must be supported by a declaration or affidavit. As set forth in MPEP 716.02(g), "the reason for requiring evidence in a declaration or affidavit form is to obtain the assurances that any statements or representations made are correct, as provided by 35 U.S.C. 24 and 18 U.S.C. 1001".

In response to applicant's arguments against Kane and Cai individually it is noted that, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In the instant case Kane is silent with regard to specifically stating that the bag or sack comprises a first surface for receiving water and allowing the water to flow into and through the package and a second surface that allows for the beverage to flow there through so that the beverage can be collected in the receiver of the device, in addition to being silent with respect to the pressure resistant bed comprising at least one continuous porous piece in the form of a web, a mat, a compacted piece, a foam or a combination thereof, that the first and second surfaces being disk-shaped sheets, a sealing seam for interconnecting the filter paper, and processing the package in an extraction device thus facilitating the formation of a foam on the beverage where the material is filter paper or plastic. However Cai teaches a method for making coffee, espresso, hot chocolate, mocha, latte or the like using a pod. "The pod contains first and second flavor-containing materials which are intended to be different materials to make blended drinks such as latte, cappuccino, mocha, milk-containing coffee and flavored espresso or coffee drinks. For example, when the first flavor-containing materials is the amount of milk particles required for making latte and the second flavor-containing materials is espresso coffee grounds, latte will be made from the pod (col. 9 lines 61-64, col. 10 lines 1-5). It is noted that latte includes foam.

Cai further teaches a method for using the pod to make coffee, espresso, hot chocolate, mocha, latte or the like. The method comprises placing the pod(s) into a pod holder, forming a seal between the side wall and/or sealing seam of the pod(s) and the substantially vertical side wall of the pod holder when the pod is placed into the pod holder and the sealing seam is positioned inside the substantially vertical side wall of the pod holder (col. 6 lines 47-65), mounting the pod holder to a beverage apparatus, (col. 10 line 52-54) introducing hot water to the pod and forcing the water through the flavor-containing materials to extract or dissolve the flavor-containing materials to form fluid comestible, and discharging the fluid comestible into a receptacle such as a cup (col. 11 lines 1-10) through the filter paper (col. 5 line 26) or plastic body thereof (col. 5 line

47).